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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/334,843 11/04/94 DRORI

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WELDON, EXAMINER

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ART UNIT PAPER NUMBER

2609

DATE MAILED: 07/17/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☒ This application has been examined ☒ Responsive to communication filed on June 1, 1995 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire Three month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

- ☒ Claims 95, 96, 98-106 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
- ☒ Claims 1-95, 97 have been cancelled.
- ☐ Claims _____ are allowed.
- ☒ Claims 95, 96, 98-106 are rejected.
- ☐ Claims _____ are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
- ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

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1. Applicant's arguments filed June 1, 1995 have been fully considered but they are not deemed to be persuasive.

First, the claims have to be supported by the original disclosure.

Second, as previously stated, "As indicated in In re Knowlton, 481 F.2d 1357, 178 USPQ 486 (CCPA 1973), the invention claims must be described somewhere in the specification".

Applicant has stated that encoders such as 16 "were well known in the art at the time" the invention was made. As previously stated when the claims are not supported by the specification", it is left to the artisan to try to find out for himself precisely what is intended or will work to effect the suggested operations" (see In re Knowlton). Further, "affidavits or declarations presented to show that the disclosure of an application is sufficient to one skilled in the art are not acceptable to establish facts which the specification itself should recite: In re Smyth, 1951 C.D. 449, 90 USPQ 106, 38 CCPA 1130" (see MPEP 716).

Applicant has stated, "there is no legal requirement that a program must be set out in flow chart or code form in order for a microprocessor-controlled invention to be enabled". Although in Exparte Butler, 217 USPQ 290, it was stated, "35 USC 112 contains no requirement for structural disclosure". Yet, it was set forth in this decision that a flow chart is "presented to enable a

worker in the art to practice the invention. Since a microprocessor is a software driven device, flow charts can be presented to enable a worker to practice the invention. When no such charts are presented, the completeness of the disclosure can be questioned.

Applicant has recognized, "whether the user programs the card or not is not addressed by the reference (i.e. Aydin)". Hence, it is obvious that a user or anyone could preprogram the unit.

To eliminate Sander et al as a reference, applicant's declaration should show his invention predates Sanders et al application serial number 588,575 filed March 12, 1984. Further, "Applicant does not deny that, as of the effective filing date of this application, remote control vehicle security systems were known, which are armed or disarmed by the remote transmitter".

Applicant has erroneously stated that the dependent claims "stand allowable as patentably distinct from the invention of claim 95". Pinnow ('046) suggests program switch accessible. As pointed out above, manufacturer encoding is not precluded by the art of record.

The reasons for ordering a large number of microprocessors have not been completely associated with the success of any device. The processors could have been used in other device or the price of these processors could have been the determining

factor.

If the invention was in production prior to May 14, 1987, it should clearly be established when the first unit was sold.

In reference to the Declarations by Ze'ev Drori and MacAmirpoor, the diagrams should be associated with the Figures in the present case.

Note that applicant has referred to U.S. Patent 5,146,255. This should be U.S. Patent 5,146,215.

Here note, "claims may be differently worded and still define the same invention" (see MPEP 804). The claims in U.S. Patent 5,146,215 are directed to "arming or disarming" a security system the same as in the present case.

In view of the above statements, the previous rejection will be repeated.

2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention.

The declaration of Mr. Ze'Ev Drori has been noted. However,

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it does not contain supporting matter for the encoder unit (16), control (14), microprocessor (142).

In Mr. Carl Angotti's declaration there is no explicit statement that a Supertex ED9 "can only detect a single security "key" signal. The invention of the Patent Application allows for the detection of several keys in a single receiver".

Mr. Angotti has referred throughout his declaration to elements never mentioned or properly incorporated in the original specification (see MPEP 608.01(P)). The material shown in Figures C-1 to A-5 would appear to be necessary to support one embodiment in the present disclosure. Such is not in the present disclosure. Therefore, the Declaration by Mr. Angotti suggests the incompleteness of applicant's original disclosure.

Essential material has not been provided by incorporation by reference to U.S. patents and by submission of software program in order for the functionally disclosed control unit 14 and microprocessor 142 to have the claimed capabilities.

The encoder unit (16), control (14), microprocessor (142) are not specified as to known commercial design product or the like. Absent is essential software specification to provide basis for many of the claimed functional features, the microprocessor operations and means, the arming/disarming functions and access functions, the programming mode and receiving mode functions, and arming/disarming functions.

For the claimed features to have basis in the specification detailed description of control unit 14 and microprocessor 142 (a software program) should be specified.

As set forth in MPEP 608.01(p), "an application as filed must be complete in itself in order to comply with 35 USC 112". On pages 12-15 of applicant's response filed January 30, 1989, there are arguments directed to structure which would support functions set forth in the original specification and drawings. However, none of the structures or programs is in the original disclosure.

The description of the elements and programs in issue in the original disclosure and their interaction in the system can, in general, only be described as conceptual. As indicated in In re Knowlton, 481 F.2d 1357, 178 USPQ 486 (CCPA 1973), the invention claims must be described somewhere in the specification. Otherwise, it is left to the artisan to try to find out for himself precisely what is intended or will work to effect the suggest operations.

As indicated in In re Scarbrough, 500 F.2d 560, 180 USPQ 298 (CCPA 1974), the statute requires the application itself to inform, not direct others to find out for themselves.

The CCPA (In re Prater and Wei; 162 USPQ 541) held, "Apparatus and process claims broad enough to encompass operation of programmed general-purpose digital computer are not

necessarily unpatentable; once a program has been introduced". Applicant's microprocessor with a memory is a digital computer. Therefore, its functions can only be supported by a disclosed program. Such a program was not in the originally filed disclosure.

3. Claims 95, 96, 98-106 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

4. Claims 95, 96, 98-106 are rejected under 35 U.S.C. § 103 as being unpatentable over Pinnow ('046) in view of Aydin, Tolson, and Sanders et al.

Pinnow teaches an electronically programmable remote control vehicle (column 4, lines 43-47) security (e.g. locking) system comprising a portable hand-held (e.g. pencil watch. See column 3, line 6) transmitter comprising means (column 2, line 55) for generating and transmitting a determined digitally encoded receiver signal or signals (column 3, lines 14-16), actuating means 24 for actuating said generating and transmitting means (column 3, lines 35-40 suggest plural key or transmitting means) so that said signal or signals are automatically generated and transmitted; a system control unit to obviously be disposed within said vehicle comprising receiving means 48 operable during a system program mode and a system operating-receiving mode for receiving said transmitted encoded signal and generating an

electrical signal representative of the encoded signal by amplifier 50; a digital memory (column 9, lines 17-25) for storing data representative of control signal; programming and operating means 52. Pinnow does not teach a radio frequency system.

At the time that the invention was made, Tolson (column 3, lines 53-62) had disclosed the interchangeability of a light and radio system. One of ordinary skill in the art having Tolson would readily find obvious that the teaching in Tolson could be used to substitute a radio signal for a light signal in Pinnow.

In column 2, lines 50-54, Pinnow points out that his invention can be used to replace a card. Aydin (column 9, lines 30-32) teaches a predetermined time delay means which can be used in a programmable security system. Since Pinnow's invention can be substituted for a card in Aydin, the teaching in Aydin can obviously be used in Pinnow because their teachings are interchangeable.

In column 6, lines 4-6, Pinnow suggests the next code received by a lock from a transmitter will reprogram the lock and the transmitter can have minimum features. The key 15 in Aydin has a minimum of features and is preprogrammed as set forth in the claim. As set forth in column 4, lines 29-34 of Aydin, the preprogrammed key can reprogram a lock as suggested in Pinnow. These preprogram and reprogram codes would not be known by a user

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as required by the claims. Aydin also uses such a wireless key in column 3, lines 66-67.

One of ordinary skill in the art having Aydin would be motivated to use a minimum feature transmitter as suggested in Aydin in Pinnow.

At the time that the invention was made, the patent to Sanders et al, in view of the interchangeable wireless teaching in Tolson, had disclosed that a wireless unit as set forth in Pinnow could be used to arm or disarm a security device.

5. Claims 95, 96, 98-106 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-10 of prior U.S. Patent No. 5,146,215. This is a double patenting rejection.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U. Weldon whose telephone number is (703) 305-4389.


Serial No. 334,843

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

U. Weldon:tlr
July 11, 1995


ULYSSES WELDON
PRIMARY EXAMINER
GROUP 2600